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In re Application of

Pierre Rebreyend et al.

Serial No. 09/605,882

Filed: June 29, 2000

For: PLASMA TORCH, METHOD OF FABRICATING AN OPTICAL FIBER PREFORM
AND PREFORM FABRICATION SYSTEM USING THE METHOD

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.44 TO WITHDRAW THE
RESTRICTION REQUIREMENT mailed April 12, 2002 and treated as an election without
traverse in the office action mailed June 19, 2002.

On April 12, 2002, a three way restriction requirement was made by the examiner. The
examiner took the position that two of the groups were related as combination /subcombinations
and that the third group was related to the other groups as a process and apparatus for its
practice. Applicants traversed the restriction requirement in a response filed May 13, 2002 and
amended the claims in an attempt to overcome the restriction requirement. The examiner treated
the election as an election without traverse in an office action mailed June 19, 2002 and
withdrew the non-elected claims from consideration. Applicants continued to argue the
restriction requirement in responses filed on October 9, 2002 and April 4, 2003.

On April 4, 2003, the instant petition under 37 CFR 1.144 was filed to formally request the
withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not
interpreted the claims properly and that he has not shown that the separate groups are distinct.

DECISION

Sections 803 and 806.05(c) of the MPEP state:

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two
or more claimed inventions only if they are able to support separate patents and they are
either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - §

806.05(c) Criteria of Distinctness for Combination, Subcombination, or

Element of a Combination

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search.

See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

806.05(e) Process and Apparatus for Its Practice — Distinctness

In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c).

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.

If the apparatus claims include a claim to “means” for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed, rejoinder is required. See MPEP § 809.04.

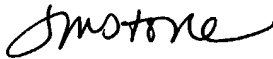
The original restriction requirement will be addressed first. The only argument presented by Applicants in response to the original restriction requirement was that they disagree with the examiner’s interpretation of “plasma torch type”. The examiner stated in the office action that the combination did not require the particulars of the subcombination. This position is deemed to be reasonable in that original claim 1 required that the torch contain means for injecting a gas...so as to reduce the power of said plasma in said area. The combination claim did not require such a limitation but rather a generic plasma torch. The restriction requirement between the apparatus and the method of use was not argued. On its face, this requirement also appears to meet the necessary criteria for restriction as set forth in the cited MPEP section above.

Applicants attempted to overcome the restriction requirement by amending the claims so that all of the newly presented claims were dependent on the same independent claim. While this amendment resulted in claims that are clearly related, this does not change the basis upon which the restriction requirement was based. Claims directed to an apparatus and the method of using said apparatus were still present, therefore the restriction requirement was still applicable. Applicants did not present any arguments directed to the basis set forth in the restriction requirement. In the arguments filed April 4, 2003, Applicants argue that all of the claims are directed to the same patentable invention. This is clearly not the case however because there are claims directed to an apparatus and method of using said apparatus. These two different statutory classes of invention are not directed to the same patentable invention. Again, no arguments were set forth arguing the specific basis upon which the restriction was made (i.e. that the inventions are distinct).

In the instant petition, it is argued that the examiner has supported his restriction by interpreting the phrase “of the plasma torch type,” as not requiring a plasma torch. It appears that petitioner

did not completely understand the basis upon which the restriction was made. To this end, it is conceded that the position taken by the examiner could have been made clearer during the prosecution of the application. However, the pertinent sections of the MPEP upon which the requirement were based was cited in the office action. When judging the appropriateness of the restriction in conjunction with this criteria, the requirement was proper.

Accordingly, the petition for withdrawal of the restriction requirement is **DENIED**. It is noted that this application has since become abandoned for failure to respond to the office action mailed November 4, 2002. If this application is revived, then the restriction requirement will be deemed to be proper and the non-elected claims will still be withdrawn from consideration.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Sughrue Mion Zinn Macpeak & Seas PLLC
2100 Pennsylvania Avenue NW
Washington DC 20037-3213